



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/887,746

06/21/2001

Takashi Kunii

393032026400

7489

25224

7590

11/03/2006

MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,746

Applicant(s)

KUNII, TAKASHI

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 19-40, 47-49 and 56-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 41-46 and 50-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/1/05, 2/2/06, 3/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of group I (claims 1-18, 41-46, 50-55) in the reply filed on 8/7/06 is acknowledged. Claims 19-40, 47-49, 56-58 are hereby withdrawn from examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18, 52, 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1-5, 10-14 each recite a "processor adapted to <perform method steps>". It is unclear how a processor can "adapted to" do anything without an instruction set. Perhaps applicant should claim the processor in combination with a computer readable medium containing instructions for accomplishing <the method steps>, yet it is noted that applicant already has such claims pending (claims 50, 51, 53, 54).
- Claims 6-9, 15-18, it is unclear what type of claim (apparatus or method) this is. The preamble states a system (apparatus) that connects a client and server. Such an introduction appears to therefore be limited to the network infrastructure between the two nodes, however the claim continues with features regarding both the client and the server. Further, each node

apparatus is apparently defined by actions performed by the node – suggesting a method claim. If applicant intended the claim to be a system including both the client and server devices in combination, the claim preamble should be amended accordingly. Further, each device should be programmed or configured to perform (functionality) steps rather than described as actually performing those steps.

- Claims 52, 55, it is unclear how a single processor can be fed with instructions that accomplishes functionality by both a client and a server. Perhaps applicant should claim the combination of the server processor and the client processor as well as the necessary instructions encoded on separate machine-readable mediums.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-18, 41-46, 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blass et al (US6296489).**

Regarding claims 1, the claims are directed to a server which selects targeted ads for music training users. Blass et al teaches the concept of musical training over the Internet by way of students downloading teacher's training content and the student

uploading his musical creations for review and analysis [4:3-15, 7:1-20, 8:14-19, 11:30-54]. Blass et al teaches that demographically targeted ads may be selected (based upon certain client information) and sent to the music training students [4:47-55]. While these claims reference client information including the type of musical instrument being used by a client, this client information is not functionally related to the rest of the claim, as there is no client which collects and reports the needed information upon which targeting is made. Regarding the specific data content present referred to in the claims of "the type of performance equipment being used in a particular client apparatus", it could be argued that Blass et al does not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The targeting steps (match the advertisement to some client-criteria to select an appropriately targeted ad) would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have relied upon any client information for targeting. Such client information does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claims 4, the claims are directed to a client which reports client information indicative of the type of musical instrument being used and which renders

Art Unit: 3622

ads received from a server. Blass et al teaches the concept of musical training over the Internet by way of students downloading teacher's training content and the student uploading his musical creations for review and analysis [4:3-15, 7:1-20, 8:14-19, 11:30-54]. Blass et al teaches that user demographics are provided to the server so that targeted ads may be selected (based upon certain client information) and sent to the music training students [4:47-55]. While these claims reference client information including the type of musical instrument being used by a client, this client information is not functionally related to the rest of the claim, as there is no server which receives the user information and makes an advertising selection based upon the information.

Regarding the specific data content present referred to in the claims of "the type of performance equipment being used in a particular client apparatus", it could be argued that Blass et al does not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The transmitting steps (send client-criteria to a server as a basis for targeting) would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have sent any client information to the server for targeting. Such client information does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claims 6, the claims are directed to a server which selects targeted ads for music training users as well as a client which receives and renders the ads. Blass et al teaches the concept of musical training over the Internet by way of students downloading teacher's training content and the student uploading his musical creations for review and analysis [4:3-15, 7:1-20, 8:14-19, 11:30-54]. Blass et al teaches that demographically targeted ads may be selected (based upon certain client information) and sent to the music training students [4:47-55]. While these claims reference client information including the type of musical instrument being used by a client, the client does not collect and report the needed information and therefore such information is not functionally related to the rest of the claim. Regarding the specific data content present referred to in the claims of "the type of performance equipment being used in a particular client apparatus", it could be argued that Blass et al does not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The reporting and targeting steps (report client information by a client, match by a server the advertisement to some client-criteria to select an appropriately targeted ad) would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have relied upon any client information for targeting. Such client information does not functionally relate to

the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Independent claims 10, 13, 15 are treated similarly. Even though they specify music content information rather than musical instrument information, they still provide non-functional descriptive material which cannot form the basis for patentability.

Regarding claims 2, 3, 5, 7-9, 11, 12, 14, 16-18, Blass et al teaches a pay-per-view model for each music lesson [6:54-56]. It would have been obvious to one of ordinary skill at the time of the invention to have used the student information such as user's type of instrument or type of music content (classical piano, jazz guitar, etc) as a basis (in addition to demographics) for advertising other similar training modules (other piano modules, other classical modules, other jazz modules, other guitar modules available from the system or pianos, guitars, classical CDs, jazz CDs, etc available from other sources).

Regarding claims 41-46, 50-55, the computer-based methods and systems of Blass et al are taken to also read on these methods and computer-instruction-based claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Boylan III et al (US6799326) teaches targeted ads based on genre as well as ads for musical instruments [11:30-45].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc